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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,369	07/01/2003	Tsuyoshi Mima	00862.023128	1190
5514 7590 05/16/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER HUNTSINGER, PETER K	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 05/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/609,369	Applicant(s) MIMA, TSUYOSHI	
	Examiner Peter K. Huntsinger	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings were received on 10/14/03. These drawings are acceptable.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Image Processing Apparatus Which Scans Location Information To Authenticate Printing An Original Image.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 recites the limitation "wherein when the original image of the document is output to the external device via a network" in lines 1-3. There is insufficient antecedent basis for this limitation in the claim.

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6. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites the limitation "wherein when the image read by said read means is output" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim because the limitation in claim 1 recites outputting the original image, not image read by read means.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 8 is directed to a program. For claim 8 to be statutory, the applicant must state "A computer readable medium storing a program" (or equivalent) not a program comprising a computer readable medium.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 5, and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Mori '590.

Referring to claim 1, Mori '590 discloses an image processing apparatus which reads a document and outputs the document to a printing device or external device,

comprising: read means for reading an image on the document (identification code read section 8 of Fig. 1, col. 5, lines 10-25); authentication means for authenticating whether a user can utilize an original image of the document (col. 3, lines 32-39, identification code may be a password) when the image read by said read means contains image storage information representing a location where the original image of the document is stored (col. 3, lines 60-67, identification code indicates image in storage section 4); search means for searching an image storage device which stores the original image of the document on the basis of the image storage information when the user is authenticated by said authentication means (storage section 4 of Fig. 1, col. 3, lines 40-45, retrieves the print image corresponding to identification code which is considered searching); and output means for outputting the original image of the document formed by search by said search means to the printing device or external device (printing section 5 of Fig. 1, col. 3, lines 46-53).

Referring to claim 2, Mori '590 discloses wherein the image storage information includes information represented by a barcode (col. 3, lines 32-39, identification code assigned as a bar code).

Referring to claim 5, Mori '590 discloses means for causing the printing device to print the image storage information (printing section 5 of Fig. 1, col. 3, lines 46-53), and causing the image storage device to store the original image of the document (col. 3, lines 60-67, print image stored in storage section 4).

Referring to claim 7, see the rejection of claim 1 above.

Referring to claim 8, see the rejection of claim 1 above.

Referring to claim 9, see the rejection of claim 1 above.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori '590 as applied to claim 1 above, and further in view of well known prior art.

Referring to claim 3, Mori '590 discloses wherein the image storage device includes a device connected via a network (col. 4, lines 43-58, network control means capable of assessing other external machines). Mori '590 does not disclose expressly a server. Official Notice is taken that it is well known and obvious for a external machine on a network to be a server (see MPEP 2144.03). The motivation for doing so would have been to provide a large storage to store a plurality of documents. Therefore, it would have been obvious to combine well known prior art with Mori '590 to obtain the invention as specified in claim 3.

Referring to claim 6, Mori '590 discloses read means for reading an image on the document but does not disclose expressly outputting the read image with no authentication performed. Official Notice is taken that it is well known and obvious in the art to output a read image without performing authentication (see MPEP 2144.03). Further, a conventional copy machine operates by reading an image and outputting the

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image without authentication. The motivation for doing so would have been to combine the functions of a standard copy machine with the system of Mori '590. Therefore, it would have been obvious to combine well known prior art with Mori '590 to obtain the invention as specified in claim 6.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori '590 as applied to claim 1 above, and further in view of applicant's admitted prior art.

Referring to claim 4, Mori '590 discloses wherein the original image of the document is output to the external device via a network (col. 4, lines 43-58, network control means capable of assessing other external machines). Mori '590 does not disclose expressly attaching the original image to an e-mail and outputting the e-mail. The applicant's admitted art teaches wherein output means attaches the original image to E-mail, and outputs the E-mail with the original image (page 1, paragraph 23-27). At the time of the invention, it would have obvious to a person of ordinary skill in the art to email a scanned image to a server. The motivation for doing so would have been to send the image to a central location for long-term storage. Therefore, it would have been obvious to combine the applicant's admitted prior art with Mori '590 to obtain the invention as specified in claim 4.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Mahoney '843

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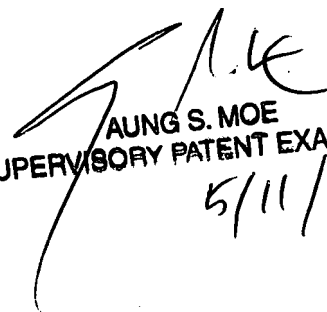
Lopresti '308

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moe Aung can be reached on (571)272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PKH



AUNG S. MOE
SUPERVISORY PATENT EXAMINER
5/11/07